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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/121,596 07/24/98 MAYAUD

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TM02/0327

EXAMINER

RIMELL S
ART UNIT PAPER NUMBER

2166
DATE MAILED:

03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/121,596

Applicant(s)

MAYAUD, CHRISTIAN

Examiner

Sam Rimell

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70, 72-92, and 94-102 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 70, 72-92 and 94-102 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: ____.

SAM RIMELL
PRIMARY EXAMINER
AU 2166

Claims 70, 72-92 and 94-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The last three lines of claim 70, and the last two lines of claim 99 are indefinite. It is not clear whether these claims are limited to only one of the alternatives presented, or multiple alternatives. Markush type language is recommended to resolve this basis of indefiniteness.

Claims 85, 91, 94, and 100-102 state that either a database or a pharmacy is "offsite". The reference to "offsite" is vague and confusing, since these claims do not define any structures as being "on-site". As result, the claims do not allow for a physical distinction between "offsite" and "on-site".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 70, 72-83, 91-92, 94-99, and 101-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Schrier et al. ('599).

Schrier et al. discloses a system having a user computer (112) having graphical user interfaces (figures 2-22) which permit the capture of prescription information and which are ultimately provided to create a prescription (col. 4 lines 43-45). The computer is connected to a network system which provides: (1) information about a patient's medical history and prescription history (col. 6 lines 5-11); (2) information about pharmaceuticals arranged by medical conditions (FIG. 3); and (3) information about the properties of pharmaceuticals (Figs 6,

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7 and 10-22). The computer (112) is connected to a network of computers as part of a hospital or other type of clinical setting (col. 5 lines 18-24). No patentable weight is attributable to who runs or operates the other computers that the computer (112) communicates with, since this has no bearing on the physical structure of the system.

The user computer (112) can gather information or transmit information to the other computers in the network (col. 5, lines 18-24).

Information about patient histories, drug information and costs can be gathered from the other computers in the network (col. 5, lines 18-24).

The system permits a prescription to be sent electronically to a pharmacy (col. 14, line 67).

The information about the pharmaceuticals can be recorded in the order in which they are prescribed to a user (col. 15 line 6) or in alphabetical order (232 in FIG. 3).

The information about the pharmaceuticals can be recorded in order of the body system treated or drug category (234 in FIG. 3 illustrates drug categories, but certain categories are specific to treatment of certain body systems, for example, antifungals are specifically used for treatment of the skin and anti-depressants are specifically used for the central nervous system).

The graphical user interface of the user computer (112) can also suggest alternative medications with alternative costs (FIG.9).

"Discarding" a current version of a patient medical history or any other stored file information and replacing it with an updated medical history or file is inherent in a computer system with a random access memory. An updated file can be saved by replacing the updated file with the original file, without saving the original file.

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The system of Schrier et al. also permits a patient medical history to include the identification of one or more prescriptions (col. 6, line 8 "concomitant drugs") and an identification of the individual prescribing the drugs (col. 21, line 42 "Health ID").

The graphical user interface of the user computer (112) in Schrier et al. also provides suggested dosages (FIG. 5).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 84-90 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al. ('599) in view of Ballantyne et al. ('821).

Ballantyne et al. discloses the usage of personal digital assistants (10) as a user computer in a telemedicine environment. It would have been obvious to one of ordinary skill in the art to substitute a personal digital assistant for the user computer (112) in Schrier et al. so as to allow the user the advantage of mobility, as taught by Ballantyne et al.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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